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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,232	07/24/2000	JOHN ROGER SAMPSON	SAMP-US1	2557

7590 05/22/2002

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EXAMINER

LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 05/22/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/582,232

Applicant(s)

SAMPSON, JOHN ROGER

Examiner

Carlos Lopez

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-15 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-15 and 27-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of the smoking article in Paper No. 7 was acknowledged. Applicant in Paper No. 9 request that claims 24-26 should be reconsidered because they are drawn to the elected product claims. This is not found persuasive because claims 24-26 are method claims. The first words in claim 24-26 recite "A method of producing...", clearly shows that claims 24-26 are method claims. There is no evidence provided by the Applicant that a claim whose first words recite " A method of producing ..." is contradictive and in fact is a product claim. If Applicant wished to claim the limitations recited in claims 24-26 he may have presented said claims with product by process language in accordance with U.S practice.

The requirement is still deemed proper and is therefore made FINAL.

### ***Response to Amendment***

The amendment filed on 3/12/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the term "porosity" being amended to "inherent porosity". Applicant is required to cancel the new matter, or show where in the specification the phrase/clause/word has antecedent basis, in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1731

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1) Claim 9-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for a wrapper having an inherent permeability of at least 20 coresta units. The specification at the time of filing only discloses a permeability of 20 C.U but does not specify that the permeability is being defined as inherent permeability as claimed by applicant.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2) Claims 9, 12, 15, 27, 28, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedge (US 3805803) in view of Hayden et al (US 5109876). Hedge discloses a tobacco rod comprising a blend of shredded tobacco and reconstituted tobacco (Example 2). The reconstituted tobacco is treated with activated carbon having a particle size less than 150 microns and may comprise up to 50% by weight (Column 1, lines 20ff). The reconstituted tobacco may be in the form of a sheet (Column 1, lines 57-62). Hedge is silent disclosing the claimed porosity of the tobacco

Art Unit: 1731

rod wrapper. However, as taught by Hayden et al wrappers typically have an inherent porosity below 400 C.U (Column 3, lines 53-64). Hence, at the time the invention was made it would have been obvious to a person of ordinary skill in the art to wrap Hedge's tobacco rod with a conventional cigarette wrappers.

3) Claims 10, 11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedge (US 3805803) in view of Hayden et al (US 5109876) as applied to claim 9 above and in further view of Raker et al (US 5261425). Hedge and Hayden are silent disclosing sources of carbon. However, the claimed sources of carbon are well known in the art as disclosed by Raker (Column 12, lines 40ff). Hence, at the time the invention was made it would have been obvious to a person of ordinary skill in the art to use carbon particles with the cigarette resulting from the combination Hedge and Hayden with conventional sources of carbon particles as taught by Raker et al.

### ***Response to Arguments***

Applicant's arguments with respect to claims 9-15 have been considered but are moot in view of the new ground(s) of rejection. The Hedge et al reference is still being applied to formulate the new rejections. Examiner will address the arguments presented to the Hedge et al reference only. Applicant argues that Hedge et al use extruded filaments as a source of reconstituted tobacco. While Hedge's example 2 shows reconstituted tobacco in the form of extruded filaments, Hedge et al clearly teaches that reconstituted tobacco may optionally be obtained in the form of sheets (Column 1, lines

Art Unit: 1731

35ff). One of ordinary skill in the art, as taught by Hedge, may have optionally used with the expectation of reasonable success, reconstituted tobacco sheets instead of extruded filaments of reconstituted tobacco.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on 8am - 5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers

Art Unit: 1731

for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

C.L  
May 19, 2002

  
**JOSE FORTUNA**  
**PATENT EXAMINER**